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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,390	08/02/2001	Jeffrey Yu	021106-000210US	7476

20350 7590 04/04/2006

TOWNSEND AND TOWNSEND AND CREW, LLP  
TWO EMBARCADERO CENTER  
EIGHTH FLOOR  
SAN FRANCISCO, CA 94111-3834

EXAMINER

PASS, NATALIE

ART UNIT PAPER NUMBER

3626

DATE MAILED: 04/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Interview Summary

Application No.

09/922,390

Applicant(s)

YU, JEFFREY

Examiner

Natalie A. Pass

Art Unit

3626

All participants (applicant, applicant's representative, PTO personnel):

(1) Natalie A. Pass.

(3) Joseph Thomas.

(2) George B.F. Yee (Reg. No. 37,478).

(4) \_\_\_\_\_.

Date of Interview: 23 March 2006.

Type: a) ☒ Telephonic b) ☐ Video Conference

c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☒ No.

If Yes, brief description: \_\_\_\_\_.

Claim(s) discussed: 1 in particular, and all of record, in general.

Identification of prior art discussed: Lewis in particular.

Agreement with respect to the claims f) ☐ was reached. g) ☐ was not reached. h) ☒ N/A.

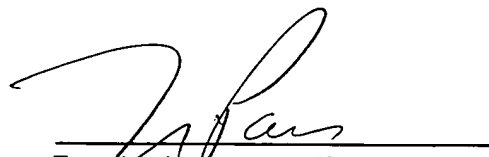
Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: See Continuation Sheet.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN A NON-EXTENDABLE PERIOD OF THE LONGER OF ONE MONTH OR THIRTY DAYS FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

  
JOSEPH THOMAS  
SUPERVISORY PATENT EXAMINER

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

  
Examiner's signature, if required

## Summary of Record of Interview Requirements

### Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

### Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews

#### Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

#### 37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case. It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,  
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

### Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

Continuation of Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments:

Discussion revolved about clarification of the rejections set forth in the prior Office Action and suggestions for possible changes to the claim language that could help put the claim limitations in better condition for allowance or appeal.

With regards to Applicant's claimed limitations in claim 1 involving "standardized types of reports," it was noted that Examiner is giving the claimed elements their broadest reasonable interpretation, as required by MPEP § 2106, which states: Office personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969). See also In re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

It was suggested that the claims would better differentiate over the applied art if "standardized types of reports" were more clearly defined in the claim language, and were defined without reference to organs, so that a report type could be selected independently of organ selection, providing this feature was supported in the specification. It was also suggested that the "selecting" step be more actively recited.

Examiner will reconsider the references in light of amendments made that clarify the claims.

**TOWNSEND  
and  
TOWNSEND  
and  
CREW**

LLP

Denver, Colorado  
Tel 303 571-4000

San Francisco, California  
Tel 415 576-0200

Seattle, Washington  
Tel 206 467-9600

Palo Alto

379 Lytton Avenue  
Palo Alto  
California 94301-1431  
Tel 650-326-2400  
Fax 650-326-2422

## FACSIMILE COVER SHEET

Date: March 3, 2006	U.S. Appl. No. 09/922,390 (our docket 021106-000210US)	Pages (including this one): <u>4</u>
TO: Examiner Pass, Natalie U.S. PTO - Art Unit 3626	Fax Number: 571 273 - 6774	

From : George B. F. Yee, Reg. No. 37,478

RE: U.S. Appl. No. 09/922,390  
Telephonic interview on March 23 at 12PM (eastern time)  
outline and proposed claim amendments

Dear Examiner Pass:

Thank you very much for granting an interview on this application.

Following is an outline of the points for our discussion, and an accompanying PTO FORM 413A.

1. Lewis et al. (U.S. Publ. No. 2001/0041992) is the Section 102 reference, and the primary Section 103 reference.
2. The claims are directed to generating a report. We will use claim 1 below as an example.
  - a. claim 1 recites in part
    - i. *"presenting an operator with an on screen menu of a plurality of standardized types of reports"* and
    - ii. *"presenting the operator with an on screen organ list corresponding to the selected ...f report"*
  - b. Fig. 4A of Lewis shows their interface
    - i. a menu of organ systems (404), where the user drills down an anatomic model to a desired anatomical structure (paragraph [0059])
    - ii. various fields (e.g., 407, 408, 409) provide information on the selected anatomical structure (paragraph [0061], bottom half)

## FACSIMILE

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3. The Office action ("the OA") also cited Fig. 4A and cited paragraphs [0049]-[0050], [0053], and [0061]; however:
- a. the explanation given of Fig. 4A does not correspond with the recited claim limitations in terms of what is selected and what is displayed
    - i. the OA refers to paragraphs [0049]-[0050] for standardized reports; these paragraphs discuss industry codes for specifying healthcare information
    - ii. the OA refers to element 404 for the recited presenting the operator with an organ list
    - iii. however, as explained in paragraphs [0059] and [0061]
      1. the user first selects the anatomical structure, paragraph [0059]
      2. then the user is presented with healthcare information for the selected anatomical structure in fields 407, 408, paragraph [0061]
      3. this sequence is opposite to the recited limitation which read:
        - a. presenting operator with list of reports
        - b. presenting operator with list of organs corresponding to a selected report
  - b. the OA cited paragraphs [0049]-[0050] for standardized reports; however, these paragraphs describe the use of codes for healthcare information, in addition to ICD9 codes (diagnostic codes) and conventional healthcare CPT codes (see paragraph [0048])
4. Summary -
- a. A system in accordance with the present invention is *report-centric*. That is, the user begins by selecting a standardized report and then is presented with a list organs corresponding to the selected report.
  - b. By contrast, the Lewis system is *anatomy-centric*. Lewis begins by drilling down an anatomic model to a desired anatomical structure, and then is presented with a list of test histories for the selected anatomical structure. This is a completely reverse process than what is recited in the pending claims.
5. We are willing to amend the claims as needed to overcome the cited art in order to move forward. However, as we understand the references, the claims as filed are patentably distinct over the art.

I look forward to discussing these points with you and with Examiner Thomas.

Sincerely,  
George

(650) 324 - 6352 (direct line)  
(650) 326 - 2422 (fax)  
gbfy@townsend.com

**FACSIMILE**

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**PENDING CLAIM 1**

1. (pending) A method of generating a patient report, comprising:
  - presenting an operator with an on screen menu of standardized types of reports;
  - having the operator select a standardized type of report from the on screen menu of standardized types of reports;
  - presenting the operator with an on screen organ list corresponding to the selected standardized type of report;
  - for each organ, presenting the operator with a menu of standard medical descriptions corresponding to the organ;
  - having the operator determine a medical description corresponding to each organ; and
  - outputting a patient report describing the medical description of each organ.

PTOL-413A (03-04)  
 Approved for use through 07/31/2006. OMB 0861-0031  
 U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

### Applicant Initiated Interview Request Form

Application No.: 09/922,390 First Named Applicant: Jeffrey Yu  
 Examiner: PASS Art Unit: 3626 Status of Application: Pending

#### Tentative Participants:

(1) Exmr. PASS (2) Exmr. Thomas  
 (3) George Yu (4) \_\_\_\_\_

Proposed Date of Interview: \_\_\_\_\_ Proposed Time: \_\_\_\_\_ (AM/PM)

#### Type of Interview Requested:

(1) ☒ Telephonic (2) ☐ Personal (3) ☐ Video Conference

Exhibit To Be Shown or Demonstrated: ☐ YES

(4) NO

If yes, provide brief description: \_\_\_\_\_

### Issues To Be Discussed

Issues (Rej., Obj., etc)	Claims/ Fig. #s	Prior Art	Discussed	Agreed	Not Agreed
(1) <u>Rej.</u>	<u>Cl. 1</u>	<u>100% 2001/04/9/92</u>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(2) _____	_____	_____	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(3) _____	_____	_____	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(4) _____	_____	_____	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
<input type="checkbox"/> Continuation Sheet Attached					

Brief Description of Arguments to be Presented:

See attached

An interview was conducted on the above-identified application on \_\_\_\_\_.

**NOTE:** This form should be completed by applicant and submitted to the examiner in advance of the interview (see MPEP § 713.01).

This application will not be delayed from issue because of applicant's failure to submit a written record of this interview. Therefore, applicant is advised to file a statement of the substance of this interview (37 CFR 1.133(b)) as soon as possible.

Applicant/Applicant's Representative Signature

Examiner/SPE Signature

Typed/Printed Name of Applicant or Representative

Registration Number, if applicable

This collection of information is required by 37 CFR 1.133. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 21 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.